Supreme Court, U. S.
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Supreme Court of the United States

October Term, 1977

No. 77-1710

NATIONAL WILDLIFE ART EXCHANGE, INC.,
AND RALPH H. STEWART,
Petitioners,

vs.

FRANKLIN MINT CORPORATION,
Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Third Circuit

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PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals
For the Third Circuit

National Wildlife Art Exchange, Inc. and Ralph H. Stewart, petitioners herein, respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit entered on April 17, 1978, affirming the judgment of the United States District Court for the Eastern District of Pennsylvania.

OPINIONS BELOW

The opinion of the District Court is reported at 195 United States Patents Quarterly 31 (E.D. Pa. 1977) and is reprinted in the appendix to this petition. The opinion of the Court of Appeals has not yet been reported and is also reprinted in the appendix to this petition.

JURISDICTION

The judgment of the United States Court of Appeals for the Third Circuit was entered on April 17, 1978. The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

QUESTIONS PRESENTED FOR REVIEW

(1) Can an artist closely duplicate his prior work and pass immunity from copyright infringement on to his publisher?

(2) Does the first publisher of limited edition prints have any enforceable copyrights against subsequent publishers when the closely duplicated prints are by the same artist?

(3) Does any publisher of a limited edition print have any enforceable copyrights against subsequent publishers when the closely duplicated limited editions are by other artists?

(4) Can the intent of Congress as expressed in the Copyright Statutes be vested in and to the sole discretion of artists whereby each artist/publisher has the sole responsibility for determining what infringes and what does not?

STATUTES INVOLVED

17 U.S.C. Sec. 101

Infringement.—If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person will be liable:

(a) Injunction.—To an injunction restraining such infringement;

(b) Damages and Profits; Amount; Other Remedies. —• • •

(1905 Act)

17 U.S.C. Sec. 501

Infringement of Copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by section 106 through 118 or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.

(b) • • •

(1976 Act)

STATEMENT OF THE CASE

A wildlife artist by the name of Albert Earl Gilbert made a first painting of a male and female cardinal on a forked branch of an apple tree in blossom which is called "Cardinals on Apple Blossom".

National Wildlife published and distributed copies of that first painting in a limited edition print of 300 for which it charged $75. The artist was paid $1500 for the painting and all reproduction rights.

Approximately three years later, the same artist made a second painting of a male and female cardinal on a forked branch of an apple tree in blossom which is called "The Cardinal". Franklin Mint published and distributed

copies of that painting in an edition of at least 6,000 copies for which it charged $120.

The second painting was the last of a series of four bird paintings done by the artist per contract with Franklin Mint. The contract provided that the artist had to submit preliminary sketches of each painting for approval, which was done for the first three paintings. For "The Cardinal", Franklin Mint was shown only a print of National Wildlife's painting.

Franklin Mint had full knowledge of the artist's prior relationship with National Wildlife and of the fact that the first painting was a success and had gone to a premium in the resale market of at least $750.

Franklin Mint sold its reproductions by direct mail solicitation from small lithographic reproductions as did National Wildlife. Over one million full color brochures were mailed out by Franklin Mint and over 9.7 million full color inserts appeared in *National Geographic, Smithsonian, Audubon* and *Natural History* Magazines.

Both works are reproduced in the appendix to this petition.[1] The clerk of this Court has been provided with color photographs of the paintings which may be inspected, as desired.

The artist created the first painting by a technique wherein he made a compositional sketch of the two cardinals on the forked apple branch in pencil on white tracing paper and transferred that sketch to the board upon which

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1. Also inserted in an envelope in the back of this Petition are negative overlay photographs of the first cardinal painting (Cardinals on Apple Blossom) and the second cardinal painting (The Cardinal). The overlays are the same size as the Franklin Mint color brochure duplication of the second painting.

he made the painting. Pencil marks so transferred onto the board served as the guide and final outline for the painting. The artist admitted using this final compositional sketch for the second painting, such sketch being reproduced in the appendix. There was no comparable sketch for the second painting.

At the argument before the Court of Appeals, counsel for Franklin Mint admitted that if the second painting had been done by another artist, Franklin Mint "would have settled in a minute".

Except for the fact that the copyrighted and accused works were done by the same artist, National Wildlife should have prevailed. National Wildlife proved access and per the above statement Franklin Mint admitted substantial similarity.

It is inconceivable that one artist could have admitted using another artist's final compositional drawing in creating a painting, testified that he did not copy and that such testimony would have been given any weight. It is likewise hard to believe that the Court of Appeals would have drawn its fine "variation on a theme" line had another artist painted the second work.

The result is that a double standard has been established wherein artists will now be able to closely duplicate prior work and pass on immunity from copyright infringement to their publishers, to their mutual profit and to the considerable damage of the first publisher and to the limited edition print industry as a whole.

The District Court did not pass on the question of substantial similarity to an ordinary lay observer. The Court of Appeals acknowledged that there were indeed obvious similarities between the two works but that such

similarities concerned "the idea" which may not be copyrighted but not the "expression" which may be protected.

There were reproductions of more than twenty-two paintings of cardinals in evidence, all presumably created under the same conventions and restraints under which the artist here involved worked, and none of them are at all similar to the paintings in issue. The line drawn by the Third Circuit between not copyrighting "the idea" and copyrighting "the expression" cannot be reconciled against the background context of the cardinal paintings done by other artists.

A reproduction of the closest cardinal painting by other artists is reproduced in the appendix to this petition.

National Wildlife first sued Franklin Mint in Florida. Franklin Mint brought a second-filed suit in Pennsylvania and was able to have the Florida action transferred to Pennsylvania because the Florida District Court had a much greater case load than the Pennsylvania District Court.

There was a question of the appealability of the final order in the case. Franklin Mint moved for attorney fees on March 4, 1977, filed a notice of appeal on March 10, the record went to the Court of Appeals on March 30, the appeals were docketed on April 25, and then on May 23 the District Court denied the motion for attorney fees.

Even though the parties had stipulated that the order appealed from was final, the Court of Appeals raised the issue of appealability. Franklin Mint then decided that the order was not final but the Court of Appeals then did nothing further about the matter.

REASONS FOR GRANTING THE WRIT

Paintings and other art work are regularly reproduced in limited editions. Companies purchase the copyrights from the artist and sell the reproductions to the public with the assurance and understanding that they will be unique and therefore of value. Franklin Mint's brochures said each print "will be issued in a *single, strictly limited edition.* After the edition is completed, the master plates used to create the engravings will be destroyed. *And none of these hand-engravings* will ever be issued again."[2]

If a first publisher cannot stop a second publisher from infringing the copyrights on the first publisher's output and thereby maintain the integrity of his offerings, copyrights have no value. An artist should not be able to closely duplicate prior work and pass immunity from copyright infringement on to his publisher.

This Court held that a copyright should be a "valuable enforceable right" *Washington Publishing Co. v. Pearson,* 306 U.S. 30, 36 (1939). The decision below makes a mockery of that holding.

The Third Circuit seemed to feel that it was maintaining the right of artists to express themselves, but all it did was to create chaos in the art world and ruin the business of National Wildlife because its credibility and integrity has been destroyed.

The decision below is precedent setting and it is a very bad precedent which should be reversed. It has far-reaching adverse implications in the art world.

After extensive hearings, Congress passed a new copyright act which became effective January 1, 1978. There

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2. Each of Franklin Mint's so-called *hand-engravings* bear the legend "Printed in Canada."

is absolutely nothing in the new copyright act which says that an artist can closely duplicate prior work and pass immunity from copyright infringement on to his publisher. There is nothing in the old act to that effect either. The test of copyright infringement should be the same without regard to the author.

The Second Circuit Court of Appeals had a similar case in *Gross v. Seligman*, 212 Fed. 930 (2nd Cir. 1914) in which a photographer took a photograph of a nude model and sold it to a first publisher. The photograph sold well. A few years later the photographer took a second photograph of the same model in a very similar pose and sold that to a second publisher. The first publisher sued the second publisher. The Second Circuit granted relief and sustained the copyright. There is a conflict between this decision and that decision.

At the oral argument of this case, the Court of Appeals expressed concern over the appropriate test to be applied to determine substantial similarity for copyright infringement purposes. The circuits do not agree upon this test, see, for instance, *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) at pages 1163-1167 where the Second Circuit's "abstractions test" *Nichols v. Universal Pictures Corporation*, 45 F.2d 119 (2nd Cir. 1930) and that court's "extrinsic" and "intrinsic" tests are discussed.

In its decision, the Third Circuit spoke of painters like Winslow Homer, Monet and Degas, but ignored the current work of the other artists, here wildlife artists, which directly related to the issues before it and the standard from which the works should have been judged. None of the artists referred to by the Third Circuit were painting for limited edition purposes. Modern advances in lithography whereby an original painting can now be reproduced by a printer has spawned a new industry. The decision below will destroy this industry.

Just as this Court laid out the steps to be followed in determining the validity of a patent in *Graham v. John Deere*, 383 U.S. 1 (1966), so the Court should now lay out the steps to be followed in determining copyright infringement.

THE WRIT SHOULD BE GRANTED

(1) To resolve the conflicts between the Second, Third and Ninth Circuits and reverse the erroneous precedent setting decision below.

(2) To decide important questions of Federal law which have not been but should be settled by this Court.

(3) To decide a question of great public interest in the art and publishing worlds.

Respectfully submitted,

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APPENDIX

JUDGMENT ENTRY OF THE COURT OF APPEALS FOR THE THIRD CIRCUIT

(Dated April 17, 1978)

Nos. 77-1525, 77-1526 & 77-1527

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

FRANKLIN MINT CORPORATION

vs.

NATIONAL WILDLIFE ART EXCHANGE INC.
and RALPH H. STEWART
(D.C. Civil No. 76-1935)

NATIONAL WILDLIFE ART EXCHANGE, INC.

vs.

THE FRANKLIN MINT GALLERY OF AMERICAN ART, INC.
(D.C. Civil No. 76-2753)

National Wildlife Art Exchange, Inc. and
Ralph H. Stewart, Appellants in 77-1525

National Wildlife Art Exchange, Inc.,
Appellant in 77-1526

Franklin Mint Corporation,
Appellant in 77-1527

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Present: ALDISERT, VAN DUSEN and WEIS, *Circuit Judges*.

JUDGMENT

These causes came on to be heard on the records from the United States District Court for the Eastern District of Pennsylvania and were argued by counsel on February 22, 1978.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court filed February 22, 1977, be, and the same is hereby affirmed. Costs taxed against appellants in all appeals.

Attest:

/s/ Thomas Quinn
Clerk

OPINION OF THE COURT OF APPEALS FOR THE THIRD CIRCUIT

(Filed April 17, 1978)

Nos. 77-1525, 77-1526 & 77-1527

UNITED STATES COURT OF APPEALS
FOR THE THIRD CIRCUIT

FRANKLIN MINT CORPORATION

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NATIONAL WILDLIFE ART EXCHANGE INC.
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National Wildlife Art Exchange, Inc., and
Ralph H. Stewart, Appellants in 77-1525

National Wildlife Art Exchange, Inc.,
Appellant in 77-1526

Franklin Mint Corporation,
Appellant in 77-1527

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

Argued February 22, 1978

Before: ALDISERT, VAN DUSEN and WEIS, *Circuit Judges*.

WEIS, *Circuit Judge.*

Nearly two centuries ago, Lord Mansfield identified the conflicting interests underlying copyright law in his oft quoted warning:

> "[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded." *Cary v. Longman,* 102 Eng. Rep. 138, 140 (K.B. 1801), *quoting Sayre v. Moore* (Hil. 1785).

The necessity of balancing these divergent concepts is illustrated in this case in which we are asked to determine whether an artist infringed a copyright, which he had once owned, by painting another work portraying the same general subject matter. The district court found no infringement and, being in agreement, we affirm.

In a series of suits and cross suits, Albert Earl Gilbert and Franklin Mint Corporation were accused of infringing on the purported copyright of National Wildlife Art Exchange, Inc. to a painting, "Cardinals on Apple Blossom." After a bench trial the district court found that the copyright was valid, but there had been no copying and, consequently, no infringement. Companion cases of defamation, disparagement, and unfair competition were also decided by the district court but have not been pursued on these appeals, which are confined to the infringement claim.

In late July or early August, 1972, Ralph H. Stewart began to implement a plan of organizing a business enterprise which would publish and market limited edition prints of wildlife. He telephoned Gilbert, a nationally recognized wildlife artist, and asked him to paint a water color of cardinals. Gilbert agreed and in the following months completed "Cardinals on Apple Blossom," using as source material color slides, photographs, sketches, and two stuffed cardinal specimens. He signed and dated the painting, and placed a copyright notice on it before August 25, 1972, the day when Stewart came to the artist's residence and approved the rendition. While there, Stewart gave Gilbert a check in the amount of $1,500, bearing on the back a notation, "For Cardinal painting, 20 x 24 including all rights—reproduction etc." On the following day, Stewart and Gilbert discussed a proposal to incorporate National Wildlife Exchange, Inc. to market prints of Gilbert's future works. They agreed in general on the plan but it was understood that at a later date attorneys for both parties would draw up a contract in terms meeting their approval. Gilbert endorsed Stewart's check and cashed it on August 28, 1972.

Early in September, 1972, Gilbert delivered the painting to Stewart. That same month, Stewart incorporated National and transferred the painting to it. In connection with his activities for National, an outline of the design of "Cardinals on Apple Blossom" was embossed on his white business cards. No color was applied to the design and no copyright notice was printed on the cards.

National placed a representation of the painting in the fall 1972 Newsletter to Members of the Cornell University Laboratory of Ornithology. No copyright notice of National was affixed but Gilbert's was visible. National published a brochure encaptioned "Introducing a First," in December, 1972 which sought orders for prints of "Cardinals on Apple Blossom," and in the next month,

it distributed an edition limited to 300 prints of the painting. All bore Gilbert's copyright notice. A year later, National filed for copyright registration of "Cardinals on Apple Blossom" which was subsequently granted.

Gilbert and National ultimately were unable to agree upon terms of the business venture discussed in August of 1972, and in January, 1975, Gilbert agreed to paint a series of four water color birdlife pictures, including one of cardinals, for Franklin Mint Corporation. The series was completed in January of 1976, and included a work entitled, "The Cardinal." Franklin made engravings of the four paintings which were sold as a group and not separately.

In painting "The Cardinal," Gilbert used some of the same source material he had utilized for "Cardinals on Apple Blossom," including preliminary sketches from his collection, photographs, slides, and a working drawing. In addition, however, he used other slides of foliage taken after completion of the earlier painting and sketches specifically developed for "The Cardinal," as well as a series of cardinal photographs. He did not use the stuffed bird specimens which had served as models for "Cardinals on Apple Blossom."

After hearing extensive testimony and viewing Gilbert's rendition of a cardinal painted in the courtroom during the trial, the district judge found that the artist had not copied "Cardinals on Apple Blossom" when he painted "The Cardinal." The court also determined that title to the copyright of "Cardinals on Apple Blossom" passed to Stewart when he purchased the painting with the $1,500 check bearing a limited endorsement. In addition, the court ruled that distribution of Stewart's business card did not constitute a publication without notice which would

forfeit National's copyright protection. And, since Gilbert's copyright notice appeared on the picture in the Cornell bulletin, the court decided that no forfeiture occurred by such publication.

Unlike a patent, a copyright protects originality rather than novelty or invention—conferring on the owner the sole right to reproduce the work and to "control all the channels through which . . . work or any fragments of . . . work reach the market." Chafee, *Reflections on the Law of Copyright*: *I*, 45 COLUM. L. REV. 501, 505 (1945). It has been said: "Originality in this context 'means little more than a prohibition of actual copying.'" *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 103 (2d Cir. 1951) (citations omitted). If there is no copying, there can be no infringement. *Mazer v. Stein*, 347 U.S. 201, 218 (1954); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904 (3d Cir.), *cert. denied sub nom. Universal Athletic Sales Co. v. Pinchock*, 423 U.S. 863 (1975); *Alfred Bell & Co. v. Catalda Fine Arts, supra*, at 103 & n.16. Copying done from memory is as objectionable as that done by tracing or direct view, *Herbert Rosenthal Jewelry Corp.* v. *Kalpakian*, 446 F.2d 738, 741 (9th Cir. 1971); *Withol v. Wells*, 231 F.2d 550 (7th Cir. 1956). Circumstantial evidence of access to the protected work and substantial similarity between it and the alleged infringing work can be used to infer copying when direct evidence is lacking. *See Reyher v. Children's Television Workshop*, 533 F.2d 87 (2d Cir.), *cert. denied*, 429 U.S. 980 (1976); *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947).

To reconcile the competing societal interests inherent in the copyright law, copyright protection has been extended only to the particular *expression* of an idea and not to the idea itself. *See Mazer v. Stein, supra* at 217-18;

Baker v. Selden, 101 U.S. 99, 102-03 (1879). In *Dymow v. Bolton*, 11 F.2d 690, 691 (2d Cir. 1926), the court observed:

> "Just as a patent affords protection only to the means of reducing an inventive idea to practice, so the copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can usually reach that, if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result and no infringement will exist."

See also Comment, *"Expression" and "Originality" in Copyright Law*, 11 Washburn L.J. 440 (1972).

Since copyrights do not protect thematic concepts, the fact that the same subject matter may be present in two paintings does not prove copying or infringement. Indeed, an artist is free to consult the same source for another original painting. As Justice Holmes stated: "Others are free to copy the original [subject matter]. They are not free to copy the copy." *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903).

Precision in marking the boundary between the unprotected idea and the protected expression, however, is rarely possible, *see Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931), and the line between copying and appropriation is often blurred. Troublesome, too, is the fact that the same general principles are applied in claims involving plays, novels, sculpture, maps, directories of information, musical compositions, as well as artistic paintings. Isolating the idea from the expression and determining the extent of copying required for unlawful appropriation necessarily depend to some degree on whether the subject matter is words or symbols written on paper, or paint brushed onto canvas.

Moreover, in the world of fine art, the ease with which a copyright may be delineated may depend on the artist's style. A painter like Monet when dwelling upon impressions created by light on the facade of the Rouen Cathedral is apt to create a work which can make infringement attempts difficult. On the other hand, an artist who produces a rendition with photograph-like clarity and accuracy may be hard pressed to prove unlawful copying by another who uses the same subject matter and the same technique.[1] A copyright in that circumstance may be termed "weak," *see First American Artificial Flowers, Inc. v. Joseph Markovits*, 342 F.Supp. 178, 186 (S.D.N.Y. 1972), since the expression and the subject matter converge. *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977); *Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra.* In contrast, in the impressionist's work, the lay observer will be able to differentiate more readily between the reality of subject matter and subjective effect of the artist's work. The limitations imposed upon the artist by convention are also factors which must be considered. A scientific drawing of a bird must necessarily be more similar to another of the same nature than it would be to an abstract version of the creature in flight.

The "copying" proscribed by copyright law, therefore, means more than tracing the original, line by line. To some extent it includes the appropriation of the artist's thought in creating his own form of expression. In *Uni-*

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1. *Compare* Esquire, Inc. v. Varga Enterprises, Inc., 81 F.Supp. 306, 307-08 (N.D. Ill. 1948), *aff'd in relevant part, rev'd in part*, 185 F.2d 14, 20 (7th Cir. 1950), *with* Gross v. Seligman, 212 F. 930 (2d Cir. 1914).

versal Athletic Sales Co. v. Salkeld, supra at 907, we observed:

> "To establish a copyright infringement, the holder must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the two works. . . . Phrased in an alternative fashion, it must be shown that copying went so far as to constitute improper appropriation, the test being the response of the ordinary lay person."

In that case, the district court had found copying but made no specific finding that would meet the second test—"that of substantial similarity in the sense of an appropriation of the original work." Copying which had been determined by dissection of the two works at issue was not sufficient, we said, because:

> "substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement. As the *Arnstein* case points out, dissection and expert testimony in the former setting are proper but are irrelevant when the issue turns to unlawful appropriation." *Id.*

In the case *sub judice*, testimony was presented by experts for the respective parties to support and refute substantial similarity. There are indeed obvious similarities. Both versions depict two cardinals in profile, a male and a female perched one above the other on apple tree branches in blossom. But there are also readily apparent dissimilarities in the paintings in color, body attitude, position of the birds and linear effect. In one, the male cardinal is perched on a branch in the upper part of the picture and the female is below. In the other, the positions of the male and female are reversed. In one, the attitude of the male is calm; in the other, he is agitated

with his beak open. There is a large yellow butterfly in "Cardinals on Apple Blossom," and none in "The Cardinal." Other variances are found in the plumage of the birds, the foliage, and the general composition of the works. Expert testimony described conventions in ornithological art which tend to limit novelty in depictions of the birds. For example, minute attention to detail of plumage and other physical characteristics is required and the stance of the birds must be anatomically correct.

There was also testimony on the tendency of some painters to return to certain basic themes time and time again. Winslow Homer's schoolboys, Monet's facade of Rouen Cathedral, and Bingham's flatboat characters were cited. Franklin Mint relied upon these examples of "variations on a theme" as appropriate examples of the freedom which must be extended to artists to utilize basic subject matter more than once. National vigorously objects to the use of such a concept as being contrary to the theory of copyright. We do not find the phrase objectionable, however, because a "variation" probably is not a copy and if a "theme" is equated with an "idea," it may not be monopolized. We conceive of "variation on a theme," therefore, as another way of saying that an "idea" may not be copyrighted and only its "expression" may be protected.

The district court had the opportunity to hear the testimony from the artist and found credible his statement that he did not copy. For further support, Gilbert painted a third picture, "The Cardinal" while in the courtroom and without referring to either of his earlier paintings. The court determined that although some of the same source materials were used in all three paintings, similarity between the works necessarily reflected the common theme or subject and each painting was a separate artistic effort.

It is well settled that credibility determinations are uniquely the province of the fact-finder. *Government of the Virgin Islands v. Gereau*, 502 F.2d 914, 921 (3d Cir. 1974), *cert. denied*, 420 U.S. 909 (1975). Although evidence of access and similarity between the paintings constitute strong circumstantial evidence of copying, they are not conclusive, *Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra*, 2 M. NIMMER ON COPYRIGHT, §§ 139.4 at 605, 141.2 at 613-14 (1976). The trial court's finding of no copying, based as it is on the testimony of the artist and other evidence of creativity, may be overturned only if it is clearly erroneous. *Rosen v. Loew's, Inc.*, 162 F.2d 785 (2d Cir. 1947). This situation is different from that in *Universal Athletic Sales Co. v. Salkeld, supra*, where we passed on the question of similarity between the copyrighted and accused work *after* copying had been established to determine if there had been appropriation. There, we were in as good a position to make a judgment as the trial court. Here, however, we have not had the opportunity to hear and see the witnesses and, thus, are not in the position to judge credibility as was the district judge. Accordingly, we conclude that the district court did not err in finding that there was no copying.

Even if it be assumed that the trial court's finding was based only on an application of a mechanical standard of copying—a tracing concept—without consideration of the appropriation factor, we would affirm. We have examined the two paintings and based upon our own observations and impressions, we conclude that while the ideas are similar, the expressions are not. A pattern of differences is sufficient to establish a diversity of expression rather than only an echo. *Universal Athletic Sales Co. v. Salkeld, supra; Herbert Rosenthal Jewelry Corp. v. Kalpakian, supra* at 741-42. The similarities here are of a nature not calculated to discourage an artist in the

development of a specialty yet sufficiently distinguishable to protect his creativity in that sphere. Just as Justice Holmes would not ban the ballerinas of Degas, we may not excommunicate the Cardinals. *See Bleistein v. Donaldson Lithographing Co., supra* at 251.

We conclude that the district judge did not err in finding that there was no copyright infringement. Consequently, we need not decide whether there was a forfeiture of the copyright by publication of the business cards. Similarly, since there was no infringement established, we do not address ourselves to the issue of whether the district court erred in finding that National had acquired Gilbert's copyright.

The judgment of the district court will be affirmed.

/s/ Joseph Weis, J.
Circuit Judge

MEMORANDUM OPINION OF THE DISTRICT COURT

(Filed March 15, 1977)

IN THE UNITED STATES DISTRICT COURT

FOR THE EASTERN DISTRICT OF PENNSYLVANIA

FRANKLIN MINT CORPORATION v. NATIONAL WILDLIFE ART EXCHANGE, INC., and RALPH H. STEWART	Civil Action No. 76-1935
ALBERT EARL GILBERT v. NATIONAL WILDLIFE ART EXCHANGE, INC.	Civil Action No. 76-1956
NATIONAL WILDLIFE ART EXCHANGE, INC. v. THE FRANKLIN MINT GALLERY OF AMERICAN ART, INC.	Civil Action No. 76-2753

MEMORANDUM OPINION*

The above three cases involving the validity of a copyright and disputes related thereto, have been consolidated for this bench trial. I make the following:

*The following opinion was dictated from the bench, transcribed by the court reporter, and edited for minor corrections of errors that appeared in the stenographic transcript.

FINDINGS OF FACT:

1. National Wildlife Art Exchange, Inc. ("National"), is a Florida corporation with its principal office in Vero Beach, Florida.

2. Franklin Mint Corporation ("Franklin") is a Pennsylvania corporation with its principal office in Franklin Center, Pennsylvania.

3. Albert Earl Gilbert ("Gilbert") is an adult individual who at all times material to these proceedings was a citizen and resident of Connecticut.

4. Gilbert is a self-taught wildlife artist and is reputed to be one of the foremost contemporary wildlife artists in the United States.

5. Ralph H. Stewart ("Stewart") is an adult individual who at all times material to these proceedings was a citizen and resident of Vero Beach, Florida.

6. Stewart, a college graduate, is a public accountant and has worked in matters of public finance and record keeping for municipal officials in Indian River County, Florida.

7. Stewart was the principal incorporator of National, and at all times material to these proceedings was its majority stockholder and chief operating officer. Stewart transacted business in the Commonwealth of Pennsylvania on behalf of National as well as on his own behalf.

8. In June, 1971, Gilbert and Stewart entered into a written contract pertaining to the marketing of prints of Gilbert's painting of a peregrine falcon. This venture was abandoned and the painting was subsequently returned to Gilbert by Stewart.

9. In late July or early August, 1972, in a telephone conversation, Stewart asked Gilbert to paint a water color picture of cardinals.

10. In this telephone conversation Stewart informed Gilbert that he, Stewart, now had sufficient capital to organize a business to publish and market limited edition prints of wildlife subjects.

11. Gilbert orally agreed with Stewart to prepare a water color painting of cardinals with the understanding that Stewart, if he did not approve of the painting, would have no economic obligation to Gilbert.

12. The terms of the oral agreement did not provide any advance financing from Stewart to Gilbert.

13. Thereafter, during August of 1972, Gilbert painted "Cardinals on Appleblossom" using as his source material certain 35 mm color slides, photographs, sketches and two stuffed cardinal specimens. None of this source material was supplied by Stewart.

14. On August 25, 1972, Stewart came to Gilbert's residence in Connecticut, which at that time was in Ridgefield, to view "Cardinals on Appleblossom". Prior to August 25, 1972, Gilbert had signed and dated the painting and placed a copyright notice upon it.

15. In the late afternoon of August 25, 1972, Stewart approved of "Cardinals on Appleblossom" and delivered a check made payable to Gilbert in the amount of $1,500.

16. This check was drawn on Stewart's personal account as a public accountant.

17. Before delivering the check to Gilbert, Stewart endorsed on the back of the check the following legend: "For Cardinal painting 20 x 24 including all rights—reproduction, etc." On August 28, 1972, Gilbert endorsed the check and had it deposited for collection.

18. It was the intention of the parties that Stewart would purchase "Cardinals on Appleblossom" for the sum of $1,500.

19. On Saturday, August 26, 1972, Stewart and Gilbert conferred at Gilbert's home.

20. During this conference Stewart made certain notes outlining a proposed transaction between Stewart and Gilbert which transaction contemplated the incorporation of National.

21. Stewart and Gilbert executed the notes for the purpose of evidencing mutual good faith, but both intended that the notes would be placed in legal form by Stewart's attorney and subsequently approved by an attorney to be engaged by Gilbert.

22. In early September, 1972, Gilbert, after placing some finishing touches on "Cardinals on Appleblossom", hand delivered that painting to Stewart in Florida.

23. In September, 1972, Stewart caused the incorporation of National to take place and thereafter received reimbursement from National for the $1,500 he paid to Gilbert.

24. Stewart subsequently delivered the notes taken at the August 26, 1972, meeting to his attorney in Florida for the preparation of a formal contract to be submitted to Gilbert.

25. In the fall of 1972 Stewart began making arrangements to market limited edition prints of "Cardinals on Appleblossom".

26. The prints of "Cardinals on Appleblossom" were to be made by lithography.

27. In the fall of 1972 Stewart caused an outline of the design "Cardinals on Appleblossom" to be embossed on his white business card. No color was utilized in depicting the design. No copyright notice appeared on the business card. Between 375 and 800 cards were distributed.

28. Stewart caused a representation of "Cardinals on Appleblossom" to be placed in the fall 1972 Bulletin of the Cornell University Laboratory of Ornithology with no copyright notice of National appearing thereon although the copyright notice of Gilbert appeared thereon.

29. On December 14, 1972, National published and distributed a brochure entitled "Introducing a First", which contained laudatory information about Gilbert, and sought orders for prints of "Cardinals on Appleblossom".

30. In January of 1973 and thereafter National distributed prints of "Cardinals on Appleblossom" which were represented by National to be part of a limited edition not to exceed 300 signed and numbered prints.

31. Both the brochure and the prints contained copyright notices in favor of Gilbert.

32. The Florida attorney for National and Stewart completed a draft of a written contract based upon the notes of the August 26, 1972, meeting.

33. Stewart substantially revised the draft prepared by his attorney and in June, 1973, submitted the revision to Gilbert.

34. Gilbert never executed the written contract revised by Stewart.

35. On December 18, 1973, National filed for copyright registration for the print "Cardinals on Appleblossom" and the brochure featuring that work.

36. At the time of said filing, National attached to its application the notes made by Gilbert on August 26, 1972, and stated in its application that Gilbert was an "artist for hire".

37. Thereafter, the Copyright Office issued copyright registration to National for "Cardinals on Appleblossom".

38. On November 9, 1972, Franklin inquired of Gilbert whether he was available to do artistic work for Franklin.

39. Gilbert referred this inquiry to National and Stewart.

40. Thereafter, Gilbert disassociated himself from National and from Stewart and in January, 1975, entered into a contractual arrangement with Franklin to paint a series of water color birdlife pictures.

41. Although at one point twenty separate paintings were contemplated, Gilbert was commissioned by Franklin to paint four, including a rendition of cardinals.

42. By January 28, 1976, Gilbert completed the four bird paintings for Franklin, including a work entitled "The Cardinal".

43. Franklin engaged an expert engraver to make engravings of the four paintings.

44. The technique Franklin developed for reproducing Gilbert's paintings included the making of a black and white engraving by applying seventeen tons of pressure per square inch to the paper, and thereafter, adding the color by lithography.

45. Franklin marketed the four prints by accepting orders for the series up to but not beyond a stated date. The purchaser was required to order all four prints.

46. The series included portrayals of two birds of prey (raptors) and two song birds (passerines).

47. Gilbert designed the painting of "The Cardinal" to be complementary in design and color to the painting of the other passerine bird entitled "The Bluejay".

48. Gilbert utilized in painting "The Cardinal" some of the same source material he had used for "Cardinals on Appleblossom". The similar source material included sketches of cardinals from Gilbert's sketch book, photographs and 35 mm slides of foliage. Gilbert also referred to a working drawing of "Cardinals on Appleblossom" when he painted "The Cardinal".

49. Gilbert, in painting "The Cardinal", used some different source materials from that which he used in painting "Cardinals on Appleblossom". The different source material included photographic slides of foliage which were taken after "Cardinals on Appleblossom" was completed.

50. There are similarities between "Cardinals on Appleblossom" and "The Cardinal" including:

(a) Both depict two cardinals, one a male and the other a female.

(b) The cardinals in both are perched on forked apple branches which are in blossom.

(c) In both pictures, the beak of one of the birds is open.

(d) The presentation of the birds in both pictures is similar in that one is above the other and they are facing to the viewer's right.

(e) Some of the foliage in both pictures is similar.

(f) The legs of the birds in both pictures are similar.

51. There are differences between "Cardinals on Appleblossom" and "The Cardinal" including:

(a) "Cardinals on Appleblossom" has as one of its three focal points a large yellow butterfly while there is no butterfly in "The Cardinal", which has only two focal points;

(b) The female cardinal is at the top of "Cardinals on Appleblossom" and at the bottom of "The Cardinal".

(c) The male cardinal in "Cardinals on Appleblossom" is leaning toward the large butterfly with his beak open, his tail feathers fanned and his crest erect. The male cardinal in "The Cardinal" is less agitated.

(d) There is a small leafhopper near the female cardinal in "Cardinals on Appleblossom" while there are no insects depicted in "The Cardinal".

(e) The blossoms shown in "The Cardinal" are in a later stage of development than in "Cardinals on Appleblossom".

(f) "The Cardinal" is complementary to "The Bluejay" while "Cardinals on Appleblossom" is not.

(g) The attitude or posture of the cardinals in the two pictures is dissimilar.

(h) Some of the foliage in "The Cardinal" is different from the foliage in "Cardinals on Appleblossom".

(i) There are discernible differences in the color and feathers between the birds in "The Cardinal" and the birds in "Cardinals on Appleblossom".

(j) "The Cardinal", being engraved contains numerous black lines illustrating body feathers which lines do not appear on "Cardinals on Appleblossom."

52. "The Cardinal" is not traced from "Cardinals on Appleblossom".

53. "The Cardinal" is not a free-hand copy of "Cardinals on Appleblossom".

54. "The Cardinal" is not copied from "Cardinals on Appleblossom".

55. On December 3, 1976, the Copyright Office, because of date discrepancies in the application, requested National to return its certificate of copyright registration GP 89824, on "Cardinals on Appleblossom" for cancellation.

56. On or about January 12, 1977, the Copyright Office reissued a copyright registration to National for "Cardinals on Appleblossom".

DISCUSSION

In this case National is suing Franklin for equitable relief and money damages for copyright infringement, defamation and unfair competition. Franklin seeks declaratory and injunctive relief against National and Stewart to confirm noninfringement and, in addition, claims money damages for defamation. Gilbert requests injunctive and declaratory relief against National to confirm noninfringement as well as money damages for defamation.

By agreement of counsel and with the concurrence of the court, the liability issues will first be decided, and

if National is entitled to money damages, further hearings will be held. The liability phase of this litigation involves the resolution of four principal issues which are: is National entitled to copyright "Cardinals on Appleblossom"; if so, are National's copyrights valid; if they are, does "The Cardinal" infringe National's copyrights; and has any party made out a case in his or its favor of defamation, disparagement or unfair competition?

I. *Entitlement to the Copyright*

Franklin and Gilbert dispute National's alleged ownership of the copyrights to "Cardinals on Appleblossom". In its December 18, 1973, filing with the Copyright Office, National relied on the notes of the August 26, 1972, meeting to pass title to the right to copyright "Cardinals on Appleblossom". However, those notes, signed by Gilbert and Stewart, consist of scribbling which is difficult to decipher. Stewart's attorney was unable to prepare an acceptable draft of a formal contract from those notes. In some instances Stewart and his attorney made subsequent additions to the notes. In any event, the notes can rise no higher than a letter of intent, and under Florida law, which the parties stipulated to be applicable to the notes, an agreement to enter into an agreement is unenforceable. *See Brown v. Dobry,* 311 So.2d 159 (Fla. Dist. Ct. App. 1975); *O'Neill v. Corporate Trustees, Inc.,* 376 F.2d 818 (5th Cir. 1967). Furthermore, the notes dated August 26, 1972, referred to future paintings and "Cardinals on Appleblossom" had been purchased by Stewart the previous day. Therefore, no title to that work could pass under any interpretation of the notes.

However, it was the intent of Gilbert and Stewart that Stewart purchase "Cardinals on Appleblossom" for the sum of $1,500, and on August 25, 1972, Stewart de-

livered a check in that amount to Gilbert. Before doing so, Stewart endorsed on the back of the check, "For Cardinal painting 20 x 24 including all rights—reproduction, etc." Gilbert and Franklin contend that the sale was limited to the painting and the right to reproduce the painting but did not include the right to the copyright. Except in California and New York, it is generally accepted that purchase of a work of art includes all rights to copyright unless otherwise specified. NIMMER ON COPYRIGHT, page 541 (1976 ed.). Nimmer, though, is critical of this rule and terms it "unfortunate". According to Nimmer, the average artist who sells a painting to a private purchaser would "be most surprised to find that he has thereby divested himself of the right to sell post card or art-book reproductions of the work". Nimmer would decide this issue by reference to the intention of the parties. Although Gilbert testified that he intended to reserve copyrights in himself, he either should have done so by specific written agreement or not negotiated the check with the above-quoted endorsement which specifically included "all rights-reproduction". Neither was Stewart an ordinary private purchaser. Gilbert knew of Stewart's desire to market reproductions of his work of art. While Gilbert denies that he knew of the endorsement when he accepted the check and testified he first learned of it on August 28, 1972, he still could have protected himself by insisting on a check from Stewart without the endorsement or with a clarified endorsement. In this regard it should be noted that Gilbert did not deliver the painting to Stewart until approximately September 2, 1972, when he hand carried it to Florida. Therefore, I find as a fact and conclude that entitlement to all copyrights to "Cardinals on Appleblossom" passed to Stewart by virtue of the $1,500 check and the endorsement contained on the reverse side. Also, an assignment of Stewart's rights to National was con-

summated when Stewart was reimbursed for the $1,500 he had paid Gilbert.

Franklin and Gilbert introduced evidence that Stewart, following August 25, 1972, acknowledged the copyright was Gilbert's property, Stewart prepared a short-form assignment of the copyright interest in "Cardinals on Appleblossom", executed it himself and sent it to Gilbert for execution. This short form contained a recital that Gilbert was the owner of the copyright. It is urged by Franklin and Gilbert that Stewart's execution of the assignment form is an admission of the facts set forth in the recital. I reject this argument. A more likely explanation is that Stewart was seeking confirmation of his prior understanding. Also, Gilbert and Franklin introduced correspondence from Stewart which could be interpreted as confirming ownership of the copyright interest in Gilbert. Although Stewart did not choose his language carefully in correspondence subsequent to August 25, 1972, the fact remains that he previously paid $1,500 for the painting. Finally, Gilbert and Franklin contend that National's reliance on the check of August 25, 1972, to establish entitlement to the copyright is an afterthought because initially National based its claim on the notes of August 26, 1972. While that may be true, it does not change the legal effect of the August 25, 1972, transaction and the endorsement on the check delivered in consummation thereof.

II. *Validity of National's Copyright*

Gilbert and Franklin suggest that National has forfeited any of its rights to secure a copyright by publishing on Stewart's business card, without a copyright notice, a design taken from "Cardinals on Appleblossom". Stewart was identified on the business card as president of National. The design on the business card contains no color and consists of a white on white embossment or

raised impression outlining the cardinals, the butterfly and the foliage of "Cardinals on Appleblossom". Between 375 and 800 of these cards were distributed by Stewart. A similar argument is made that forfeiture of the right to obtain a copyright occurred when National caused a small picture of "Cardinals on Appleblossom" to appear in the fall, 1972, Bulletin of the Cornell University Laboratory of Ornithology.

I find that forfeiture did not occur in either instance. The distribution of the business card is not a case where the work of art or a reproduction thereof was distributed or published without the copyright notice. The size of the design on the business card is greatly reduced from the original painting, lacks color, and is presented in a different medium. In regard to the Cornell newsletter, Gilbert's copyright appears thereon although because of the reduction in size, the encircled "c" is difficult to discern. Franklin and Gilbert rely on *Eagle-Freedman-Roedelheim Co. v. Allison Mfg. Co.*, 204 F.Supp. 679 (E.D. Pa. 1962), and *Letter Edged in Black Pr. v. Public Building Commission of Chicago*, 320 F.Supp. 1303 (N.D. Ill. 1970), for the rule that publication with the omission of an appropriate copyright notice forfeits copyright protection regardless of intent. The difficulty with Franklin's forfeiture argument is illustrated by the following quotation from NIMMER ON COPYRIGHT, page 220: "Unless the basic work is reproduced (either in basic or derivative form) in the published work, it is not published." Under the circumstances present in the case *sub judice*, I find no forfeiture of copyright protection took place, because the distribution of the business card was not a publication of "Cardinals on Appleblossom".

Gilbert and Franklin also dispute the validity of National's copyright on the ground that Stewart and National

committed fraud on Gilbert and the Copyright Office. While Stewart's arrangement with Gilbert should not serve as a model of copyright practice, neither party was initially represented by an attorney. Stewart obtained all right, title and interest to "Cardinals on Appleblossom", including all copyright rights, by paying $1,500. His actions taken thereafter were done to secure his investment and, in retrospect, his documentation may have contained certain overstatements of his position. I find, however, Franklin and Gilbert have not met the burden of proving National and Stewart intended to deceive Gilbert or the Copyright Office in regard to registering the copyright for "Cardinals on Appleblossom". In patent cases, the burden to establish fraud on the Patent Office requires "clear, unequivocal and convincing" proof. *Baldwin-Lima-Hamilton Corp. v. Tatnall Meas. Sys. Co.*, 169 F.Supp. 1, 25 (E.D. Pa. 1958), *aff'd*, 268 F.2d 395 (3d Cir.), *cert. denied*, 361 U.S. 894 (1959). Neither Franklin nor Gilbert has met that heavy burden which should be equally applicable to the Copyright Office.

Franklin and Gilbert raise other technical defenses to the validity of National's copyright registration for "Cardinals on Appleblossom". One of these is that the copyright notices were in Gilbert's name while the registration was under the name of National. However, NIMMER, *supra*, at page 535, states that failure to record an assignment is not a defense to an infringer. As a result of this litigation, the Copyright Office recalled the registration and sought clarification on certain matters. Thereafter, on or about January 12, 1977, the Copyright Office reissued the registration. Suffice it to say that I conclude National has a valid copyright registration for "Cardinals on Appleblossom".

III. *The Infringement Issue*

In this circuit, to establish copyright infringement:

> [t]he holder must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the two works. The criterion for the latter requirement is whether an ordinary lay observer would detect a substantial similarity between the works.

University Athletic Sales Co. v. Salkeld, 511 F.2d 904 (3d Cir. 1975). Gilbert acknowledges that he had copies of "Cardinals on Appleblossom" on his premises at the time he painted "The Cardinal". Therefore, National has proved the element of access. It is equally clear from a visual inspection that "The Cardinal" is not a tracing of "Cardinals on Appleblossom". Nor did Gilbert copy, in the sense of free-hand copying, directly from the earlier painting to the later work.

National contends, however, that the duplication of a copyrighted original, although not exact, gives rise to a cause of action for infringement. National relies heavily on *Gross v. Seligman,* 212 F. 930 (1914) which involved alleged infringement of a copyrighted photograph. In *Gross,* a photographer sold all his rights to the first picture and two years later photographed the same model in substantially the same pose. The court in finding infringement first observed [p. 931]:

> If the copyrighted picture were produced with colors on canvas, and were then copyrighted and sold by the artist, he would infringe the purchaser's rights if thereafter the same artist, using the same model, repainted the same picture with only trivial variations of detail and offered it for sale.

According to National, the quoted language is controlling because in its view Gilbert's "The Cardinal" is a repainting "with only trivial variations" from "Cardinals on Appleblossom".

A more detailed discussion of the *Gross* case is necessary. The photographs in *Gross* were of the same nude model. The only differences in the subsequent photograph from the former were the configuration of the model's mouth, changes in her contours, slight changes in the background and the placing of a cherry stem in her teeth. In this factual context a finding was made that the later photograph was copied from the former, because a comparison revealed no difference in artistic expression. The basis for the finding of infringement in *Gross* is that the artist used his talent "not to produce another picture, but to duplicate the original".

National's reliance on *Gross* is misplaced for several reasons. The *Gross* case has been described as a "curious holding". *Copyright Protection for the Collection and Representation of Facts,* 76 HARV. L. REV. 1569, 1599 (1963). The *Gross* opinion, p. 931, itself contains an exception to the principle it applies.

> Of course when the first picture has been produced and copyrighted every other artist is entirely free to form his own conception of the Grace of Youth, or anything else, and to avail of the same young woman's services in making it permanent, whether he works with *pigments* or a camera. If, by chance, the pose, background, light, and shade, etc., of this new picture were *strikingly similar,* and if, by reason of the circumstance that the same young woman was the prominent feature in both compositions, it might be very difficult to distinguish the new picture from

> the old one, the *new would still not be an infringement of the old* because it is in no true sense a *copy* of the old. (Emphasis supplied, except for word, "copy".)

Furthermore, Gilbert's craft is to depict wildlife as accurately as possible. To do this he relies on source material that he has collected over his lifetime as well as on slides, photographs, sketches, working drawings, and specimens. Mr. Justice Holmes in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249 (1903), distinguishes between copying from original subject matter and copying from a finished work of art of a particular subject. He said:

> They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. *Others are free to copy the original. They are not free to copy the copy.* (Emphasis supplied.)

As I understand this distinction, an artist is permitted to portray cardinals in their natural state as often as he wishes without fear of infringement unless he copies from a previous artistic rendition, including his own. This is made clear by Mr. Justice Holmes later (p. 251) in his opinion:

> Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.

In addition, the *Gross* decision incorrectly relies on *Hanfstaengl v. Baines & Co.*, (L.R. 1895) A.C. 20, as authority

for finding copyright infringement. In actuality, the House of Lords in *Hanfstaengl* found no infringement occurred. At the request of National's attorney, the Court personally verified by telephone conference with the office of the Clerk for the Second Circuit Court of Appeals that there was no typographical error on this point in the printed opinion. Finally, the case at bar falls within the exception stated in *Gross* that the subsequent painting is a new artistic effort.

I am of the opinion that, although there are similarities between "Cardinals on Appleblossom" and "The Cardinal", the latter is a variation on a theme found in nature and is not a copy of the former. The absence of the large yellow butterfly in "The Cardinal" negates any striking similarity.

Expert testimony is admissible on the issue of copying. *Universal Athletic Sales Co. v. Salkeld, supra. Franklin's* experts, including several well-qualified artists and art historians, after reviewing Gilbert's source material, presented convincing opinions that "The Cardinal" is not a copy of "Cardinals on Appleblossom". These experts emphasized that it is accepted practice for artists to return to a common theme such as Claude Monet to haystacks or Winslow Homer to rural school children. Homer, for example, depicted the same children playing the game of snap the whip in two different paintings. The experts referred to a number of other examples where well-known artists consistently returned to a particular theme including Shepherd's charging bull elephants and Albers' colored squares. Also, a leading birdlife artist, Don Eckelberry, testified in Gilbert's behalf on this point. Gilbert as a wildlife artist who strives to be ornithologically correct, is limited in the number of ways he is able to present a particular bird. Gilbert, himself, testified in a credible

manner that he did not copy "The Cardinal" from "Cardinals on Appleblossom".

In support of his denial of the charge of copying, Gilbert painted, using his source materials, a third picture of cardinals. Before commencing this effort, Gilbert was sworn not to refer to "Cardinals on Appleblossom" or "The Cardinal" in any manner until the demonstration painting was completed. All of the work on the painting was done in the courtroom. This third rendition is evidence that Gilbert did not copy "The Cardinal" from "Cardinals on Appleblossom". The third painting, while similar in some respects to both of its predecessors, is in its own right a new work of art. The similarities occur because Gilbert relied on his sketch books, slides, photographs, working drawings, and bird specimens in creating the paintings. Each painting, however, is a separate artistic effort and no copying was done from one finished painting to another.

National insists that Gilbert copied from his pencil sketch working drawing of "Cardinals on Appleblossom" when he outlined "The Cardinal". While this working drawing was referred to by Gilbert, he did not trace or copy from it. The enumerated differences between the paintings are clear evidence that there was no copying. Any impression of similarity is due to the consistency of Gilbert in drawing cardinals with extreme precision in accordance with the artistic convention of presenting the birds in profile as a pair perched on forked limbs.

National's experts did not opine that Gilbert copied "The Cardinal" from "Cardinals on Appleblossom". While they found many similarities and were of the opinion that the two paintings were "too close", their testimony fell short of establishing the essential element of copying.

Both National and Franklin prepared a series of overlays to aid in the comparison of the two works. These overlays do show similarities in composition. They are not particularly helpful, however, because much of Gilbert's talent lies in his faculty of being able to present the cardinals with ornithological precision. Therefore, it is not surprising that the legs of the birds in both works are similar and that other similarities can be found. I have listed in the Findings of Fact the similarities and dissimilarities of "Cardinals on Appleblossom" and "The Cardinal". My own comparison of the paintings,[1] including placing them in juxtaposition with "The Bluejay" leads to the conclusion that Gilbert did not copy "The Cardinal" from "Cardinals on Appleblossom". *See Esquire, Inc. v. Varga Enterprises*, 81 F.Supp. 306, *rev'd on other grounds*, 185 F.2d 14 (7th Cir. 1950).

Even assuming that the similarities between "Cardinals on Appleblossom" and "The Cardinal" would shift (*See* NIMMER ON COPYRIGHT, §139.4) the burden of going forward with the evidence (to prove no copying) to Franklin and Gilbert, I find that the quantum of proof supplied by Franklin and Gilbert meets that burden. The testimony of Gilbert and the opinions of Franklin's experts coupled with my own comparison of the paintings and their source material convince me that Gilbert did not copy. Gilbert impressed me as a sensitive artist with high integrity to

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1. The words of Lord Herschell, over eighty years ago, in Hanfstaengl v. Baines & Co., (L.R. 1895) A.C. 20, 25 are still appropriate today in reaching my conclusion:

> My Lords, it is difficult, if not impossible, to put into words all the reasons which lead to the conclusion arrived at on such a question as that now before your Lordships. I have tried to indicate some of those which have led me to my conclusion; but it depends really on the effect produced upon the mind by a study of the picture, and of that which is alleged to be a copy of it, or at least of its design.

whom the concept of copying would be foreign. At the very least, the evidence presented by Franklin has rebutted any inferences of copying, and the burden of proof has shifted back to National. National has totally failed to counter the thrust of Franklin's formidable proof that no copying occurred. *Granite Music Corp. v. United Artists Corp.*, 532 F.2d 718 (9th Cir. 1976).

Since Gilbert did not copy "The Cardinal", there can be no infringement because neither cardinals nor the ballet can be "excommunicated" as subject matter for any artist, irrespective of his talent. In other words, it is the element of actual piracy which is lacking in National's case. *See Rexnord, Inc. v. Modern Handling Systems, Inc.*, 379 F. Supp. 1190 (D. Del. 1974). I find, therefore, that Gilbert has not copied "The Cardinal" from "Cardinals on Appleblossom". Accordingly, an essential element of an infringement action is lacking, and judgment against National will be entered on its claim for infringement. I further find that Franklin and Gilbert are entitled to a declaratory judgment of noninfringement.

IV. *The Defamation Issue*

Franklin has failed to prove the elements of defamation, disparagement and unfair competition in its claim against National. In fact, Franklin withdrew this claim at oral argument. Neither has National introduced any competent evidence against Franklin of defamation or unfair competition. Gilbert individually seeks damages for defamation. Gilbert has sufficiently proved a case of defamation against National in only one respect. National wrote to the National Audubon Society on September 20, 1975, stating Gilbert committed plagiarism in regard to another painting known as "Cardinals in Snow". While Stewart sincerely was of the opinion that his copyright

was infringed, this letter, since it contains an untrue accusation affecting Gilbert's professional status is libelous. No special damages were proved by Gilbert, and his counsel has stated that no additional evidence on damages would be presented. It appears from this record that Gilbert's reputation has not been tarnished by that letter. Therefore, judgment will be entered in favor of Gilbert and against National, but no damages will be awarded to Gilbert. To the extent that the foregoing discussion contains facts and conclusions not specifically set forth in the Findings of Fact and Conclusions of Law, they are incorporated herein by reference. I reach the following:

CONCLUSIONS OF LAW

1. This court has jurisdiction over the subject matter of these disputes pursuant to 28 U.S.C. §1332 and 28 U.S.C. §1338.

2. This court has in personam jurisdiction over all the parties to this litigation, including Ralph H. Stewart, who has been validly served pursuant to 42 Pa.C.S.A. §8309.

3. National Wildlife Art Exchange, Inc., is the owner of all of the right, title and interest in the painting "Cardinals on Appleblossom".

4. National Wildlife Art Exchange, Inc., holds valid copyrights to "Cardinals on Appleblossom".

5. Neither Franklin Mint Corporation nor Albert E. Gilbert has infringed the copyrights of National Wildlife Art Exchange, Inc., to "Cardinals on Appleblossom".

6. Albert E. Gilbert has established by a preponderance of the evidence a cause of action for negligent defamation of character against National Wildlife Art Ex-

change, Inc. However, no special damages were proved and no general damages will be awarded.

7. National has failed to prove by a preponderance of the evidence any cause of action against Franklin for defamation or unfair competition.

8. Judgment is to be entered in accordance with this opinion.

/s/ EDWARD N. CAHN
Edward N. Cahn, J.

First painting—"Cardinals on Apple Blossom"

A38

Second painting "The Cardinal"

A39

Franklin Mint Exhibit 83F—Compositional sketch for first painting used in making second painting

National Wildlife Exhibit 97—Closest cardinal painting by other artist

First Cardinal Painting

Second Cardinal Painting